

## **REMARKS**

Reconsideration of the present application is respectfully requested in light of the above amendments to the application and the following remarks.

### **Regarding the Drawing**

The Patent Office Official Draftsperson objected to Figs. 1 and 2 as being informal (margins and/or character of lines, numbers and letters). Replacement Figs. 1 and 2 are being submitted concurrently herewith to the Official Draftsperson.

In addition, with respect to Figure 2, it has been noted that Figure 2 refers to components 5, 6 and 23, whereas the specification at page 12, line 20 – page 13, line 7 refers to components 23, 24 and 25. In addition, there is a different component 25 in Figure 1, which is referred to in the specification as component 25 at page 12, line 11. To conform the drawing to the specification, and to eliminate the use of the same reference numeral twice for different components, Figure 2 has been amended to change the components labeled 5 and 6 to be labeled as components 26 and 24, respectively.

Figure 2 is a screen shot of an exemplary database and, between the time that the patent application was filed and today, some modifications have been made to that exemplary database. Thus, the names, extension numbers, etc., of the listings in the original drawing do not exactly match the names, extension numbers, etc., of the listings in the drawing being submitted. This is indicated by the brackets and the asterisk (\*) on the annotated Figure 2. However, the names, extension numbers, etc., in the drawings are exemplary, and not specific, and no name, extension number, etc., is specifically pointed out or relied upon in the specification or in the claims. Therefore, it is respectfully submitted that no new matter has been added.

### **Regarding the Specification**

As mentioned above, component 25 is used in Figure 1 and Figure 2 to refer to different components. The amendment changes the description with respect to Figure 2 to refer to component 26. Therefore, it is respectfully submitted that no new matter has been added.

## Regarding the Claims

Claims 1, 6, 8, 9, 10 and 13 have been amended and new claims 14 and 15 have been added. Currently pending in the application, therefore, are Claims 1-15, of which Claims 1 and 13 are independent.

Claims 1, 3-8, and 10-13 were rejected under 35 U.S.C. §103(a), as being unpatentable over Taira et al. (US Patent No. 5,930,806), and de la Hueraga et al. (US Patent No. 5,903,889).

This is respectfully traversed on the ground that Taira is non-analogous art. A reference is not analogous if it is not from the same field of endeavor as the invention. A lack of similarity in the structure and function of the invention and the prior art is indicative that the prior art is not within the inventor's field of endeavor. Specifically, Taira discloses a database conversion system, converting "from a network data model to a relational database model". (Abstract) Further, Taira is a one-way data migration system. (Col. 2, lines 10-28; Col. 3, lines 44-46; Col. 5, lines 10-24.) In addition, as further proof that Taira is a one-way data conversion scheme, and not an archiving scheme, it is noted that Taira requires that the original program be re-written to accommodate the data in its new relational database form. (Col. 6, lines 33-35 and 66-67; Col. 8, line 66 - Col. 9, line 3.)

One of skill in the art would not look at art on schemes to convert data into a relational database model in order to determine how to archive data for future use. One would also not look at a one-way data conversion scheme, which requires re-writing of the original program, in order to determine how to archive data for future use. Therefore, Taira is not analogous art and is not relevant to the claimed invention, and cannot be combined with any other art. Accordingly, it is respectfully requested that the reference to Taira be withdrawn, and it is respectfully submitted that claims 1, 3-8, and 10-13 are patentable over Taira, singly or in combination.

This rejection is also traversed on the ground that de la Hueraga is non-analogous art. A reference is not analogous if it is not from the same field of endeavor as the invention. A lack of similarity in the structure and function of the invention and the prior art is indicative that the prior art is not within the inventor's field of endeavor. Although de la Hueraga uses the word "archiving" once in the title, and the word "archived" once in the summary (Col. 3, line 22), the invention that de la Hueraga discloses is a method for allowing data records in disparate formats to be conveniently viewed through a single application, a browser. (Col. 3, lines 30-43, 55-60.) De la Hueraga's archival system is: "The system would be operable to collect all data records

pertaining to a specific patient, doctor, or other subject, modify them to support display through a Java applet, internet browser, or other universal display standard, generate additional patient files to organize the data records in a hypertext directory structure, and store the data records and files on a mass-media storage device such as a CD-ROM” (Col. 2, lines 55-62.), “to store a group of related data records organized in a hypertext tree structure to a mass storage device, such as a hard disk or CD-ROM, through which the data records may be retrieved, displayed, and controlled through a single interactive display program” (Col. 3, lines 8-13.), and “another aspect of the present invention includes means for retrieving, processing, and storing all of a patient's data records that are available on the hospital's computer network onto a mass media storage device, such as a CD-ROM” (Col. 4, lines 36-40.). Thus, de la Huerga, like Taira, is not an archiving scheme, but requires either (1) that the application program use the data in its original format, and convert it into a different format as required, or (2) that the data be converted into a new format and stored in an appropriate database, such as 106 or a CD-ROM, and that a new program (a web browser) be used to access and view the data in its new format.

With respect to the data record event, note that the cite (Col. 9, lines 30-43) states that “the data translation and collection system 110 receives a data record from a database 106 which may include or be appended to other information specifying patient identification, chronological detail, the data type, and other information regarding the record”. That is, a data record event is not being created. Rather, a hyperlinked data record is being created by linking to all of the files referenced in the original data record. This follows from reading the remainder (Col. 9, line 44 – Col. 10, line 39), wherein the result is that “the data translation and collection system 110, having translated and formatted the received data record, forwards the record and its formatted URL to an appropriate database 106 for storage.”

Thus, de la Huerga may be viewed either as a real-time data format translation system, or as a data conversion system. If the former, it is non-analogous and not applicable. If the latter, then it is a one-way data migration system, is non-analogous, and is not applicable. In addition, as further proof that the latter is a one-way data conversion scheme, and not an archiving scheme, it is noted that de la Huerga requires that a browser be used to accommodate the data in its new database form.

One of skill in the art would not look at art on data conversion and hyperlinking schemes in order to determine how to archive data for future use. One would also not look at a one-way

data conversion scheme, which requires a new application, in order to determine how to archive data for future use. Therefore, de la Huerga is not analogous art and is not relevant to the claimed invention, and cannot be combined with any other art. Accordingly, it is respectfully requested that the reference to de la Huerga be withdrawn, and it is respectfully submitted that claims 1, 3-8, and 10-13 are patentable over de la Huerga, singly or in combination.

As independent claims 1 and 13 are patentable over Taira and de la Huerga, singly or in combination, dependent claims 2-12, which depend from independent claim 1, are also patentable over Taira and de la Huerga, singly or in combination.

With respect to claim 4, the Patent Office's characterization of de la Huerga is traversed. The cited sections de la Huerga (Col. 9, lines 30-43; Col. 14, lines 26-38) do not suggest or disclose "Scheduling Object formulating a schedule optimizing the Originating System's resources relative the operation of Migrator Object." De la Huerga simply converts the data on demand. Therefore, it is respectfully submitted that claim 4 is further patentable over de la Huerga.

The Patent Office rejected claims 2 and 9 under 35 USC § 103(a) as being unpatentable over Taira and de la Huerga in view of Johnson et al., US Patent No. 5,813,009. This is also respectfully traversed. First, as shown above, Taira and de la Huerga are non-analogous art and cannot be combined with any art to show obviousness.

The Patent Office stated that "de la Huerga teaches the means which essentially comprise the same means maximum age of data records (col. 18, lines 20-30)." The cited lines of de la Huerga are claims, and do not refer to age or purging. All of column 18 has been reviewed, as well as lines 20-30 of the other columns without finding such a reference. Therefore, either de la Huerga does not teach this, or the cite is uninformative. In either event, this reference to de la Huerga is respectfully traversed.

Thus, Johnson stands alone, and the Patent Office has not asserted that Johnson, standing alone, either anticipates the claims or makes them obvious. Therefore, it is respectfully suggested that claims 2 and 9 are further patentable over Johnson.

New claims 14 and 15 require the “computer readable program code means is further for causing said data records to be removed from the Originating System” (Claim 14) and “said Migrator Object is further for causing said received data records to be removed from the Originating System” (Claim 15). Neither Taira nor de la Huerga suggest nor disclose that the data records should be removed from the originating system. Therefore, it is respectfully submitted that claims 14 and 15 are further patentable over Taira and de la Huerga, singly or in combination.

### **REQUIREMENTS TO ESTABLISH ANALOGOUS PRIOR ART**

To be analogous art, a cited reference must be “from the same field of endeavor as the invention.”

A prerequisite to making a finding on the scope and content of the prior art is to determine what prior art references are pertinent. In re Clay, 966 F.2d 656, 658 (Fed. Cir. 1992). Whether a prior art reference is analogous is a question of fact. Id. A reference is analogous if it is from the same field of endeavor as the invention. Id. at 658-59. Similarity in the structure and function of the invention and the prior art is indicative that the prior art is within the inventor’s field of endeavor. In re Deminski, 796 F.2d 436, 442 (Fed. Cir. 1986). If a reference is outside the inventor’s field of endeavor, it is still analogous art if the reference “is reasonably pertinent to the particular problem with which the inventor is involved.” Clay, 966 F.2d at 659.

*State Contracting & Engineering Corporation V. Condotte America, Inc. et al.*, \_\_ U.S.P.Q.2d \_\_\_\_ (Fed. Cir. 2003)

### **REQUIREMENTS TO ESTABLISH A PRIMA FACIE CASE OF OBVIOUSNESS**

To establish *prima facie* obviousness of a claimed invention, all claim limitations must be taught or suggested by the prior art. *In re Roy*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.P.A. 1974).

### **LACK OF PRIOR IMPLEMENTATION**

If the claimed invention was an obvious extension of the art, even the non-analogous art of Taira and de la Huerga, then the claimed invention would have been implemented earlier. However, the cited art does not disclose nor suggest the claimed invention. This lack of implementation supports Applicant’s argument that the claims are allowable. “That an inventor has probed the strengths and weaknesses of the prior art and discovered an improvement that

escaped those who came before is indicative of unobviousness, not obviousness." *Fromson v. Anitec Printing Plates, Inc.*, 45 U.S.P.Q.2d 1269 (Fed. Cir. 1997).

### NO MOTIVATION TO COMBINE REFERENCES

When an obviousness determination is based on multiple prior art references, there must be a showing of some "teaching, suggestion, or reason" to combine the references. *Gambro Lundia AB v. Baxter Healthcare Corp.*, 110 F.3d 1573, 1579, 42 USPQ2d 1378, 1383 (Fed. Cir. 1997) (also noting that the "absence of such a suggestion to combine is dispositive in an obviousness determination"). Whether motivation to combine the references was shown we hold a question of fact. See *In re Dembiczak*, 175 F.3d 994, 1000, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999) ("[P]articular factual findings regarding the suggestion, teaching, or motivation to combine serve a number of important purposes . . . .") (emphasis added); *Monarch Knitting*, 139 F.3d at 881-83, 886, 45 USPQ2d at 1982, 1985 (treating motivation to combine issue as part of the scope and content of the prior art and holding that genuine issues of fact existed as to whether one of ordinary skill in the art would have been motivated to combine the references in question).

Evidence of a suggestion, teaching, or motivation to combine prior art references may flow, *inter alia*, from the references themselves, the knowledge of one of ordinary skill in the art, or from the nature of the problem to be solved. See *Dembiczak*, 175 F.3d at 999, 50 USPQ2d at 1617. Although a reference need not expressly teach that the disclosure contained therein should be combined with another, see *Motorola, Inc. v. Interdigital Tech. Corp.*, 121 F.3d 1461, 1472, 43 USPQ2d 1481, 1489 (Fed. Cir. 1997), <sup>6</sup> the showing of combinability, in whatever form, must nevertheless be "clear and particular." *Dembiczak*, 175 F.3d at 999, 50 USPQ2d at 1617.<sup>1</sup>

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention when there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577, 2221 U.S.P.Q. 929, 933 (C.A.F.C. 1984).

Applicant respectfully submits that the claims, as now presented, are distinguishable and patentable over Taira, de la Huerga and Johnson, singly or in combination, as such references neither anticipate nor render obvious the claimed invention.

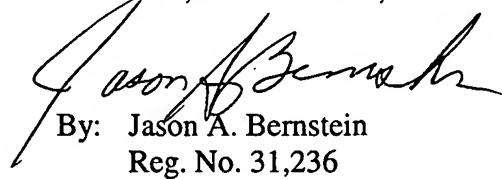
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<sup>1</sup> Quoted from *WINNER INT'L. ROYALTY v WANG No. 981553 - 01/27/2000 (CAFC)*.

Some amendments and remarks contained in this document, or in other documents filed or to be filed with the US Patent Office in this case or related cases, may in the future be deemed, by a court of law or government agency of competent jurisdiction, to be narrowing amendments and/or related to patentability. Accordingly, in view of the holdings in the cases of Honeywell International Inc. (formerly known as AlliedSignal Inc.) and Honeywell Intellectual Properties, Inc. (formerly known as AlliedSignal Technologies, Inc.), v. Hamilton Sundstrand Corporation (formerly known as Sundstrand Corp.), Deering Precision Instruments, L.L.C. v. Vector Distribution Systems, Inc., Ranbaxy Pharmaceuticals, Inc. v. Apotex, Inc., and the series of Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co. cases, the public is hereby advised that the applicant: (a) does not intend to relinquish any claim coverage except for that which is clearly, explicitly, precisely and unequivocally stated to be relinquished; (b) does not intend to relinquish any other claim coverage; (c) reserves the right to assert that any such amendments and/or remarks are not narrowing and/or are not related to patentability; and (d) intends to fully assert the full range of equivalents, under the Doctrine of Equivalents and otherwise, which are presently known or which may become known in the future, for each and every element of each and every claim, and for each and every claim. For example, the deletion of the word “An” in claim 1 is not intended to mean that only plural modules are covered, the change of the word “being” to “is” in claims 6, 8 and 10 is intended only to use proper English and not intended to vary the scope of coverage, the addition of the words “acts in” in claim 9 is intended only to use proper English and not intended to vary the scope of coverage, and the addition of “and said data words” in claim 13 is intended only to additionally require “said data words” or the equivalent thereof.

Independent Claims 1 and 13 are now believed to now be in condition for allowance, and dependent Claims 2-12 and 14, 15 are thereby also in condition for allowance. Therefore, Applicant respectfully requests the same. Should the Examiner have questions or suggestions which will put this application in line for allowance, he or she is requested to contact the undersigned attorney.

Respectfully submitted,  
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Attachments



Application No. 10/014,695  
Attorney Docket No. 141794.00001-P1363US00  
Annotated Sheet Showing Changes

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FIG. 2

Application No. 10/014,695  
Attorney Docket No. 141794.00001-P1363US00  
Annotated Sheet Showing Changes

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